UNITED STATES DEPARTMENT OF COMMERCE
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SERIAL NUMBER	FILING DATE	FIRST NAMED APPLICANT		ATTORNEY DOCKET NO.
07/047,614	05/08/87	ROCKLAGE	S	145.0002

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EXAMINER	
ROTMAN, A	
ART UNIT	**PAPER NUMBER**
121	10

DATE MAILED: 09/11/89

This is a communication from the examiner in charge of your application.

COMMISSIONER OF PATENTS AND TRADEMARKS

JUNE 28, 1989

[X] This application has been examined [X] Responsive to communication filed on _____ [X] This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), _____ days from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

1. [ ] Notice of References Cited by Examiner, PTO-892.
2. [ ] Notice re Patent Drawing, PTO-948.
3. [ ] Notice of Art Cited by Applicant, PTO-1449
4. [ ] Notice of informal Patent Application, Form PTO-152
5. [ ] Information on How to Effect Drawing Changes, PTO-1474
6. [ ] _____

Part II SUMMARY OF ACTION

1. [X] Claims 1-8 AND 10-19 are pending in the application.

   Of the above, claims _____ are withdrawn from consideration.

2. [ ] Claims _____ have been cancelled.

3. [ ] Claims _____ are allowed.

4. [X] Claims 1-8 AND 10-19 are rejected.

5. [ ] Claims _____ are objected to.

6. [ ] Claims _____ are subject to restriction or election requirement.

7. [ ] This application has been filed with informal drawings which are acceptable for examination purposes until such time as allowable subject matter is indicated.

8. [ ] Allowable subject matter having been indicated, formal drawings are required in response to this Office action.

9. [ ] The corrected or substitute drawings have been received on _____. These drawings are [ ] acceptable; [ ] not acceptable (see explanation).

10. [ ] The [ ] proposed drawing correction and/or the [ ] proposed additional or substitute sheet(s) of drawings, filed on _____. has (have) been [ ] approved by the examiner. [ ] disapproved by the examiner (see explanation).

11. [ ] The proposed drawing correction, filed _____, has been [ ] approved. [ ] disapproved (see explanation). However, the Patent and Trademark Office no longer makes drawing changes. It is now applicant's responsibility to ensure that the drawings are corrected. Corrections MUST be effected in accordance with the instructions set forth on the attached letter "INFORMATION ON HOW TO EFFECT DRAWING CHANGES", PTO-1474.

12. [ ] Acknowledgment is made of the claim for priority under 35 U.S.C. 119. The certified copy has [ ] been received [ ] not been received [ ] been filed in parent application, serial no. _____; filed on _____.

13. [ ] Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.

14. [ ] Other

The new set of drawings filed June 28 1989, have been found acceptable.

The cancellation of claims 9 and 20-54 coupled with the amendatory changes to claims 1-8, 10 and 11 has resulted in deleting all non-elected subject matter from the original set of claims.

Claims 1-8 and 10-19 are rejected under 35 U.S.C. 101 and 112 (first and second paragraphs). Specifically, the depicted formula I in claim I (twice amended) does not correspond to formulas (II), (III), and (IV) set forth in pages 9 and 10 of the specification. Applicants' claims in (twice amended) form include metal chelates and salts thereof. To take it a step further, the metal chelates are disclosed as being part of the anions; quite obviously, the claims must be depicted in ionic form, showing anions cations, coordinate-covalent bonding, ionic bonding and which atoms are attached to said metal chelates and what kind of salts are involved. The instant claims do not provide those answers and the depicted formula (II), (III) or (IV) do not specifically provide those answers they are somewhat speculative since they show (Z). That depiction does not represent absolute configuration; more guesswork than absolute bonding. Since the metal chelate ligands have valences of $(^{+2})$ or $(^{+3})$, the cation must therefore show dimers, trimers protonation sites etc., which do not find clear antecedent basis in the instant specification.

Also, with respect the term R_4 there is a semicolon after the terms alkyl having 1 to 6 carbon atoms; and no connecting term such as "or" for the term $-CH_2-O-\overset{O}{\overset{\|}{P}}-(OH_2)$ respectively.

RESPONSE TO ATTORNEY'S KEY ARGUMENT

Applicants' attorney argues in pages 4 and 5 of Paper No 6 that the rejection under 35 U.S.C. 101 and 112 is improper because the positive structures on pages 9 and 10 are not speculation, represent the correct structures as determined by laboratory structure analysis of the subject of this invention. Further, Applicants' attorney also argues that it appears that actual reduction to practice is a requirement under 35 USC 101 and 112 and the statutes and their interpretations favor an early disclosure and accept a constructive reduction to practice, established law which appears to be inconsistent with the position of the Examiner. There are 3 different arguments and each one will be addressed separately.

REBUTTAL-A

1) Applicants must be aware of what they are claiming; the metes and bounds of an ultimate patent grant must reflect applicants intent. See In re Prater et al., 162 USPQ 541 (CCPA 1969); In re Wakefield et al., 164 U.S.P.Q. 636 (CCPA 1970); In re Borkowski et al 164 U.S.P.Q. 641, 642 (CCPA 1970).

2) If applicants show formula I, and argue that antecedent basis residues in formulas (II), (III), and (IV), which appear in pages 9 and 10 of the specification, there is confusion on the part of applicants based on their own inconsistancy.

3) The burden of explaining 112 rejections resides with the undersigned Examiner. This has been done, in dealing with chelates, coordinate-covalent bonds and ionic bonds are inherently present by any chemical standard, if questioned, the burden shifts to applicants to respond accurately, which has not been done. See In re Armbruster, 185 USPQ 152 (CCPA 1975); In re Angstadt and Griffin, 190 USPQ 214 (CCPA 1976). The issue of salts thereof has not been adequately addressed by applicants.

REBUTTAL-B

If structure is based on recognized laboratory procedures e.g. NMR, then the structures in the specification should be definite.

REBUTTAL-C

(1) Such terminology as "constructive reduction to practice" is language reserved for interference practice.

(2) There is no Court decision that stands for the premise that early disclosure is favored over "a

specification must be complete as filed. Nor, has applicants cited any decision that states, early filing is proper, even though a specification is not complete as filed.

(3) Applicants have not shown where the Examiner has erred in his judgement. Merely stating a conclusion without facts or evidence does not suffice.

This action is made FINAL.

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). The practice of automatically extending the shortened statutory period an additional month upon the filing of a timely first response to a final rejection has been discontinued by the Office. See 1021 TMOG 35.

A SHORTENED STATUTORY PERIOD FOR RESPONSE TO THIS FINAL ACTION IS SET TO EXPIRE THREE (3) MONTHS FROM THE DATE OF THIS ACTION. IN THE EVENT A FIRST RESPONSE IS FILED WITHIN TWO (2) MONTHS OF THE MAILING DATE OF THIS FINAL ACTION AND THE ADVISORY ACTION IS NOT MAILED UNTIL AFTER THE END OF THE THREE (3) MONTH SHORTENED STATUTORY PERIOD, THEN THE SHORTENED STATUTORY PERIOD WILL EXPIRE ON THE DATE THE ADVISORY ACTION IS MAILED, AND ANY EXTENSION FEE PURSUANT TO 37 CFR 1.136(a) WILL BE CALCULATED FROM THE MAILING DATE OF THE ADVISORY ACTION. IN NO EVENT WILL THE STATUTORY PERIOD FOR RESPONSE EXPIRE LATER THAN SIX (6) MONTHS FROM THE DATE OF THIS FINAL ACTION.

Any inquiry concerning this communication should be directed to Alan L. Rotman at telephone number 703 557-3920

Alan L. Rotman

Alan L. Rotman
Examiner
Art Unit 121

Rotman:st

9/8/89